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10/042,616	01/09/2002	Mark J. Flanagan	2001P18375US	7020

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EXAMINER

ROCHE, TRENTON J

ART UNIT	PAPER NUMBER
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2193

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/042,616

Applicant(s)

FLANAGAN, MARK J.

Examiner

Trenton J. Roche

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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DETAILED ACTION

1. This office action is responsive to communications filed 23 May 2005.
2. As per Applicant's request, amended claims 1, 9, 19, 20, 23, 26 and 27 have been entered.
Claims 1-31 are pending.
3. Claims 1-31 have been examined.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 6, 9-11, 14, 17-21, 24, 27, 28 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,199,193 to Oyagi et al, hereafter referred to as Oyagi.

Per claim 1:

Oyagi discloses:

- a review facility for providing an item for review by a plurality of reviewers and collecting comments from reviewers (“comment-space inclusive prototype presentation means...to allow the user to write comments...” in col. 2 lines 12-16)
- preparation means for preparing an item for interactive review (“generating a comment-space inclusive prototype...” in col. 2 lines 13-14)

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- means for making prepared items available for interactive collaborative review (Note at least Figure 9 and the corresponding sections of the disclosure.)
- means for collecting comments on elements of said prepared items from said interactive collaborative review (“writes his/her comments and suggestions in the given space” in col. 5 lines 28-29. Further, “the user can send his/her comments and suggestions...in a real-time manner.” in col. 5 lines 49-51)
- means for distributing collected said comments from said interactive collaborative review (“The user’s comments and suggestions about the prototype screen are returned to the user feedback distribution unit...” in col. 5 lines 44-46)

substantially as claimed.

Per claim 2:

The rejection of claim 1 is incorporated, and further, Oyagi discloses a selection means for selecting and retrieving said item, and means for formatting retrieved said items as claimed (Note Figure 2, item S1, and the corresponding sections of the disclosure.)

Per claim 3:

The rejection of claim 2 is incorporated, and further, Oyagi discloses identifying individual elements within said item, reviewers providing comments on ones of said individual elements as claimed (Note Figure 5, item 11b, wherein the user can comment on individual items by item ID.)

Per claim 6:

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The rejection of claim 1 is incorporated, and further, Oyagi discloses means for providing items to reviewers, and reviewer selection means for selecting said items for review responsive to reviewer selection as claimed (Note Figure 5, item 11b, wherein the user can select items to review and comment on.)

Per claim 9:

The rejection of claim 1 is incorporated, and further, Oyagi discloses means for conducting a formal review, said formal review considering collected comments by reviewers participating in said formal review and previously distributed to said reviewers by said means for distributing collected comments as claimed (Note Figure 12, item S69 and the corresponding sections of the disclosure.)

Per claim 10:

Oyagi discloses:

- a method of reviewing an item being prepared for distribution, said method comprising the steps of preparing an item for interactive review (“comment-space inclusive prototype presentation means...to allow the user to write comments...” in col. 2 lines 12-16)
- making said prepared item available to a plurality of reviewers for comments on item elements, one of said plurality of reviewers returning comments on said prepared item (Note Figure 2 and the corresponding sections of the disclosure. The comment-space inclusive software is sent over a network to client computers.)
- conducting a formal review meeting of said plurality of reviewers, whereby one or more of the previously provided comments sufficiently provides attending reviewers awareness of a particular condition with respect to said item that said comment may be addressed in said

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item prior to said formal review meeting, such that further action is unnecessary at the time of said formal review with respect to said particular condition and each corresponding said comment (Note Figure 5, item 11b. The reviewers make comments, and “distributes them as user feedback to the development engineers involved in the project” (col. 4, lines 57-58) for a final review by the development engineers.)

substantially as claimed.

Per claim 11:

The rejection of claim 10 is incorporated, and further, Oyagi discloses retrieving said item for review, and formatting said item, individual item elements being identified for comment in said formatted item as claimed (Note Figure 2, item S1 and Figure 5, item 11b and the corresponding sections of the disclosure.)

Per claim 14:

The rejection of claim 10 is incorporated, and further, Oyagi discloses selecting said item, reviewing comments on said selected item, determining whether said selected item warrants additional comments, distributing warranted additional comments on said selected item, and repeating the steps until all items for review have been selected as claimed (Note Figure 5, item 11b and the corresponding sections of the disclosure. The user checks each item, and comments as necessary on that item until all items have been reviewed.)

Per claim 17:

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The rejection of claim 14 is incorporated, and further, Oyagi discloses the items being stored in a central repository and selecting said items comprises connecting over the Internet to said central repository and accessing said item as claimed (Note Figure 4 and the corresponding sections of the disclosure. The items are kept on the development computer, and once an item is selected, a replica of the item is replicated on the user's screen for comments.)

Per claim 18:

The rejection of claim 10 is incorporated, and further, Oyagi discloses the returned comments being available for display by reviewers upon receipt as claimed ("the user's comments and suggestions are distributed to the relevant development engineers" in col. 6 lines 64-66)

Per claim 19:

Claim 19 recites a computer program product for performing the actions of the review facility as disclosed in claim 1, and is rejected for the reasons set forth in connection with claim 1. Further, Oyagi discloses the limitation of presenting prepared items for formal review, said formal review considering collected comments provided by reviewers as claimed ("the user's comments and suggestions are distributed to the relevant development engineers" in col. 6 lines 64-66)

Per claim 20:

The rejection of claim 19 is incorporated, and further, note the rejection regarding claim 2.

Per claim 21:

The rejection of claim 20 is incorporated, and further, note the rejection regarding claim 3.

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Per claim 24:

The rejection of claim 19 is incorporated, and further, note the rejection regarding claim 6.

Per claim 27:

Claim 27 recites a computer-readable medium for performing the method of claim 10, and is rejected for the reasons set forth in connection with claim 10.

Per claim 28:

The rejection of claim 27 is incorporated, and further, note the rejection regarding claim 11.

Per claim 31:

The rejection of claim 27 is incorporated, and further, note the rejection regarding claim 17.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4, 5, 7, 8, 12, 13, 15, 16, 22, 23, 25, 26, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,199,193 to Oyagi et.al, hereafter referred to as Oyagi, in view of "Codestriker" by Sitsky.

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Per claim 4:

The rejection of claim 3 is incorporated, and further, Oyagi discloses commenting on individual items (Note Figure 5, item 11b and the corresponding sections of the disclosure) and further discloses building a comment file (Note Figure 7, item 12a and the corresponding sections of the disclosure). Oyagi does not explicitly disclose the individual elements being individual lines of source code. Sitsky discloses a system having the ability to comment on individual lines of source code as claimed (“submit comments against the code on a per-line basis...” on page 1). As the system disclosed by Oyagi could already indicate individual items for review, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the individual elements of the system disclosed by Oyagi be individual lines of source code, as in the system disclosed by Sitsky, thereby enabling code reviews in a collaborative fashion, as discussed on page 1 of Sitsky.

Per claim 5:

The rejection of claim 3 is incorporated, and further, Oyagi discloses commenting on individual items (Note Figure 5, item 11b and the corresponding sections of the disclosure) and further discloses building a comment file (Note Figure 7, item 12a and the corresponding sections of the disclosure). Oyagi does not explicitly disclose the individual elements being individual blocks of text in a document. Sitsky discloses a system having the ability to comment on individual blocks of text from documents as claimed (Note the diagram on page 3. A block of code in textual form is being reviewed). As the system disclosed by Oyagi could already indicate individual items for review, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the individual elements of the system disclosed by Oyagi be individual blocks of text, as in the

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system disclosed by Sitsky, thereby enabling code reviews in a collaborative fashion, as discussed on page 1 of Sitsky.

Per claims 7 and 8:

The rejection of claim 6 is incorporated, and further, claims 7 and 8 are rejected for the reasons set forth in connection with claims 4 and 5, respectively.

Per claims 12 and 13:

The rejection of claim 11 is incorporated, and further, claims 12 and 13 are rejected for the reasons set forth in connection with claims 4 and 5, respectively.

Per claims 15 and 16:

The rejection of claim 14 is incorporated, and further, claims 15 and 16 are rejected for the reasons set forth in connection with claims 4 and 5, respectively.

Per claims 22 and 23:

The rejection of claim 21 is incorporated, and further, claims 22 and 23 are rejected for the reasons set forth in connection with claims 4 and 5, respectively.

Per claims 25 and 26:

The rejection of claim 24 is incorporated, and further, claims 25 and 26 are rejected for the reasons set forth in connection with claims 4 and 5, respectively.

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Per claims 22 and 23:

The rejection of claim 21 is incorporated, and further, claims 22 and 23 are rejected for the reasons set forth in connection with claims 4 and 5, respectively.

Per claims 29 and 30:

The rejection of claim 28 is incorporated, and further, claims 29 and 30 are rejected for the reasons set forth in connection with claims 5 and 4, respectively.

Response to Arguments

8. Applicant's arguments filed 23 May 2005 have been fully considered but they are not persuasive.

Per claims 1-3, 6, 9-11, 14, 17-21, 24, 27, 28 and 31:

9. The Applicant states that Oyagi does not teach test participant comments being made available or distributed to other test participants. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., distribution of comments to other test participants) are not directly recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, the Applicant states that "While the beta test may be interactive and the individual comments from beta test users forwarded to engineers may be considered collaboration between the beta test users, this is not 'interactive collaborative review' as recited in claim 1 as amended." (note page 12 of the remarks). As the Applicant noted, the testing

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may be interactive, and the comments may be considered collaboration; consequently, it is unclear as to how this cannot be considered "interactive collaborative review," especially considering the fact that the claims are read according to the broadest reasonable interpretation of the claim language. It is believed that Oyagi discloses all the required claim limitations, and as such, the rejection regarding claims 1-3, 6, 9-11, 14, 17-21, 24, 27, 28 and 31 is proper and maintained.

Per claims 4, 5, 7, 8, 12, 13, 15, 16, 22, 23, 25, 26, 29 and 30:

The Applicant states that the Codestriker reference can only be applied under 35 U.S.C. § 103(a) as a reference under 35 U.S.C. § 102(b), but as Codestriker "was published, at least as far as the applicants can tell, on or about December 1, 2001, about 40 days prior to the filing date of the present application..." (page 10 of the remarks), it is therefore not available to be applied as a reference under 35 U.S.C. § 102(b) to find the present invention obvious under 35 U.S.C. § 103(a).

In response, it is respectfully requested that the Applicant provide the section of the MPEP which states that a publication available under 35 U.S.C. § 102(a) cannot be used in a obviousness rejection.

Indeed, note MPEP 2141.01 as recited below:

2141.01 Scope and Content of the Prior Art
I. PRIOR ART AVAILABLE UNDER 35 U.S.C. 102 IS AVAILABLE UNDER
35 U.S.C. 103

"Before answering Graham's content' inquiry, it must be known whether a patent or publication is in the prior art under 35 U.S.C. § 102." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987). Subject matter that is prior art under 35 U.S.C. 102 can be used to support a rejection under section 103. *Ex parte Andresen*, 212 USPQ 100, 102 (Bd. Pat. App. & Inter. 1981) ("it appears to us that the commentator [of 35 U.S.C.A.] and the [congressional] committee viewed section 103 as including all of the various bars to a patent as set forth in section 102.").

A 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication or issue date. (emphasis added)
For instance, an obviousness rejection over a U.S. patent which was issued more than 1 year before the filing date of the application is said to be a statutory bar just as if it anticipated the claims under 35 U.S.C. 102(b). Analogously, an obviousness rejection based on a publication which would be applied under 102(a) if it anticipated the claims can be

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overcome by swearing behind the publication date of the reference by filing an affidavit or declaration under 37 CFR 1.131.

For an overview of what constitutes prior art under 35 U.S.C. 102, see MPEP § 901 - § 901.06(d) and § 2121 - § 2129.

As noted by the Applicant, Codestriker was published prior to the filing date of the present application, and as such, would be applicable under 35 U.S.C. § 102(a), therefore, consistent with MPEP section 2141.01, is available to be applied to find the present invention obvious under 35 U.S.C. § 103(a). As such, the rejection regarding claims 4, 5, 7, 8, 12, 13, 15, 16, 22, 23, 25, 26, 29 and 30 is proper and maintained.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trenton J. Roche whose telephone number is (571) 272-3733. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Trenton J Roche
Examiner
Art Unit 2193

TJR


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